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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,743	05/01/2001	Thomas P. Feist	08CN08803A	3681

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EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/845,743

Applicant(s)

FEIST ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-75.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: applicants' arguments have been considered but are not found persuasive. Specifically, applicants re-argue that areal recording density is a "positive limitation" (page 12 of response) and that Landin et al. does not illustrate a core having a "varied thickness" (pages 12 - 13 of response). The Examiner respectfully notes that both of these arguments have been previously addressed and reiterates that the areal recording density has been given due weight, per the rejection of record. The Examiner further reiterates that the "discontinuous" cores shown by Landin et al. are cores having "varied thickness" and that applicants appear to be reading limitations from the specification into the claims by applying a narrow definition to the term "varied thickness" than the Examiner deems is proper.

Applicants further argue that the Examiner "then hypothesized that, because the reference teaches that the properties are good, an artisan is allegedly motivated to modify Landin et al. to possess these properties", but the Examiner has failed to provide any teaching, suggestion or explanation of how Landin et al. can be modified to obtain the properties desired by the prior art, i.e. that there is no expectation of success for the proposed modifications (pages 13 - 15 and 18 - 20 of response). The Examiner respectfully disagrees.

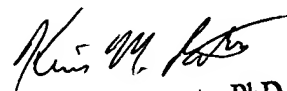
The Examiner deems that it is quite reasonable to postulate that an artisan would be motivated to achieve "good properties" since it seems unlikely that an artisan would seek to produce articles possessing known "bad properties". Regarding the explicit teaching of modifying the Landin et al. reference to obtain the requisite properties, the Examiner notes that applicants are placing an unrealistic burden on the disclosure of the prior art in a field as crowded as the recording media field. Barring a follow up reference by Landin et al. explicitly talking about the proposed modification (which would be a 102-type reference), the Examiner notes that the expectation of a separate inventors work to talk about how to modify each and every type of prior art media to achieve their novel features would require a dissertation-sized patent application, far beyond the required scope for adequate disclosure for one of ordinary skill in the art to practice the taught improvement to the art. Furthermore, the Examiner notes that such publications may not even exist prior to Nov. 1999 since if such a "modification" was found obvious, no patent would have been issued and no patent publication would have been present directed to the alleged improvement to the art. In addition, the Examiner notes that the majority of the relied upon references provide explicit teachings in how to obtain the desired properties and one of ordinary skill in the art and/or possessing of basic physics knowledge would be readily capable of achieving the desired modifications.

Applicants continue argue that "an edge lift of less than about 8 microns was not even possessed by storage media produced after the publication of the present application", despite acknowledging that the prior art reference relied upon by applicants clearly teaches otherwise (pages 15 - 16 of response).

While applicants amend their argument that "edge lifts of greater than 8 micron were common", the Examiner notes that patentability is not based on what was "common", but what was "known". Applicants appear to be confusing the concept of commercial viability with patentability. While the Examiner will readily acknowledge that it may not have been commercially viable to produce disks with the claimed edge lift, either because consumers weren't willing to pay the extra costs or commercial disk drives couldn't take advantage of the extra disk space, the fact that the recording media art clearly recognized the problem and the solution before applicants' filing date is sufficient to render the claimed edge lift obvious in view of the prior art, even if it may not have been commercially viable prior to applicants method of processing. As the Examiner has stated previously, applicants may very well have discovered a novel method of producing recording disks and a patent on the method of making the storage media would be appropriate. However, the Examiner maintains the validity of the rejections of record directed to a recording media product.

Finally, applicants argue that Yamaguchi et al. do not provide motivation for a tapered core (pages 16 - 17 of response). The Examiner respectfully disagrees.

The Examiner notes that forming films having a constant thickness onto a tapered substrate results in a recording medium having a tapered structure, as is clearly shown in the Yamaguchi et al. figures. The Examiner deems that one of ordinary skill in the art would clearly recognize that the taper can either be formed by starting with a tapered core, followed by the uniform thickness coatings or a solid substrate having a taper. The two structures are functionally equivalent and both produce the desired overall taper that is the inventive concept of the Yamaguchi et al. invention.


Kevin M. Bernatz, PhD
Primary Examiner

1/4/05